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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,730	05/08/2002	Dan L. Eaton	P3230R1C001-168	1384
30313	7590	09/17/2004	EXAMINER	
KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET IRVINE, CA 92614			SEHARASEYON, JEGATHEESAN	
			ART UNIT	PAPER NUMBER
			1647	

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/063,730	Applicant(s) EATON ET AL.	
	Examiner Jegatheesan Seharaseyon	Art Unit 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/2002</u> . | 6) <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u> . |

Continuation of Attachment(s) 6). Other: Notice to comply, Appendix A1-5..

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DETAILED ACTION

1. Applicant's preliminary amendment filed on 10 September 2002 is acknowledged and entered. Claims 1-20 are pending and under consideration. The claims are drawn to the nucleotide encoding the protein designated PRO1565, also identified as encoded by DNA737727-1673 and ATCC accession number 203459, shown in Figures 115 (nucleic acid) and 116 (protein).

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825). Applicant is required to provide a paper copy of the CRF in response to the Office Action.

Information Disclosure Statement

4. The information disclosure statement, filed 9/17/2002 has no blast searches. Thus, the Examiner cannot determine the merits of the blast search results.

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Priority Determination

5. The claimed nucleotide has no utility, see rejection below. Since no utility is disclosed in the priority applications and aren't enabling under 35 U.S.C. 112, as required under 119(e), no priority is granted. Accordingly, priority under 35 U.S.C. 120 is set at the instant filing date, 5/8/02.

Should the applicant disagree with the examiner's factual determination above, it is incumbent upon the applicant to provide the serial number and specific page number(s) of any parent application filed prior to the date recited above which specifically supports the particular claim limitation for each and every claim limitation in all the pending claims which applicant considers to have been in possession of, and fully enabled for, prior to that date.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 8-10 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6a. The protein identified as PRO1565 (SEQ ID NO: 116) is not disclosed as being expressed on a cell surface. Accordingly, the limitation that the claimed protein comprises an "extracellular domain" (for example see claims 1, 6 and 14 parts (c) and (d)) is indefinite, as the art does not recognize soluble proteins as having such domains. Further, if the protein had an extracellular domain, the recitation of "the extracellular

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domain", "lacking its associated signal sequence" (claim 1, 6 and 14, part (d), for example) is indefinite as a signal sequence is not generally considered to be part of an extracellular domain, as signal sequences are cleaved from said domains in the process of secretion from the cell. Claims 2-5, 8-10 and 15-20 are rejected insofar as they are depended on rejected claims 1, 6 and 14.

5b. Claims that recite that the claimed polynucleotide "hybridizes to" another sequence, such as claim 14, are indefinite as there is no limiting definition of such in the specification, and the metes and bounds of that which will hybridize are dependent upon the conditions under which the hybridization is performed. As the metes and bounds of what will hybridize to a given sequence are entirely dependent upon the conditions of hybridization and washing, the metes and bounds of the claims cannot be determined. With respect to claim 15, although the further limitation that the hybridization conditions are "stringent" is introduced, the term "stringent conditions" is also a relative term, and the metes and bounds of the claim cannot be determined. Claim 16 is rejected insofar as it is depended on rejected claim 14.

Rejections under 35 U.S.C. §101 and §112

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7a. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial and credible asserted utility or a well-established utility.

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Claims 1-20 are directed to isolated polynucleotides that are 80-100% identical to (a) a sequence encoding polypeptide of SEQ ID NO: 116 or (b) a sequence encoding the polypeptide of SEQ ID NO: 116 lacking signal sequence or (c) a sequence encoding the extracellular domain of SEQ ID NO: 116 or (d) a sequence encoding the extracellular domain of the polypeptide of SEQ ID NO: 116, lacking the signal sequence or (e) a polynucleotide sequence of SEQ ID NO: 115 or (f) a full-length coding sequence of SEQ ID NO: 115 or (g) the full-length coding sequence of the cDNA deposited under ATCC 203459. Dependent claims are directed to polynucleotides that hybridize to the above sequences, vectors and host cells comprising the isolated polynucleotides. The specification discloses the isolation of a polynucleotide sequence, SEQ ID NO: 115, which encodes a protein, SEQ ID NO: 116 which is disclosed as PRO1565 (see page 21). The specification contains numerous asserted utilities the claimed nucleotides, including use as a hybridization probe, in the generation of anti-sense RNA and DNA, "knock-out" animals, as a diagnostic tool, for therapeutic purposes and for the antibody production. Further, there is no disclosure that the protein encoded by the instant nucleotides is expected to be a transmembrane protein, nor of any extracellular domain. There is no biological activity, expression pattern, phenotype, disease or condition, ligand, binding partner, or any other specific feature that is disclosed as being associated with PRO1565 provided in the specification. In the instant invention, claims are directed to polynucleotide sequences encoding the polypeptide of SEQ ID NO: 116 (PRO1565).

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The specification describes the polynucleotides encoding polypeptide PRO1565 that is an unspecified secreted transmembrane polypeptide. However, the art teaches that PRO1565 is a polypeptide that is similar to Chondromodulin like protein (see Appendix A1-A5). This family of proteins does not possess a common utility, but rather the proteins that can be broadly classified and have different activities, that confer different uses on them. Accordingly, the mere identification of a protein as belonging to a family, while indicative of evolutionary relatedness, is not indicative of function, nor by extension, of utility. The structure of the putative PRO1565 peptide is briefly discussed in Figure 116, as having putative transmembrane domains, corresponding to about amino acids 25-47. Potential signal peptide sequence is described around amino acids 1-40. In addition, Applicants also describe potential glycosaminoglycan attachment sites around amino acids 70-73, 85-88, 92-95, 133-136, 148-151, 192-195 and 239-242. Applicant has also described potential microbodies C-terminal targeting signal site at amino acids 315-317. Further, potential N-myristoylation site around amino acids 33-38, 95-100, 116-121, 215-220 and 272-277 has been described. The specification also describes a potential cytochrome C family heme-binding site signature at around amino acids 9-14. However, there is no functional characteristic associated with these motifs, hence the mere observation that they exist is not probative of function or utility. Further, there is no disclosure that the protein is expected to be a secreted protein, nor of any extracellular domain. There is no biological activity, expression pattern, phenotype, disease or condition, ligand, binding partner, any other specific feature that is disclosed as being associated with PRO1565. Without any information as to the specific

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properties of PRO1565 or the polynucleotide encoding the same, the mere identification of such as having homology to a secreted transmembrane protein is not sufficient to impart any particular utility to the claimed polypeptides.

The specification discloses that PRO1565 tests positive in a single assay that stimulates the release of proteoglycans from cartilage tissue both basally and after stimulation with interleukin-1 α (see page 138, Assay 97). In this assay the proteoglycan released from cartilage is measured by a colorimetric assay. Thus, it is claimed that PRO1565 polypeptide is useful for stimulating proteoglycan release from cartilage tissue. It is further stated this activity (for stimulating proteoglycan release from cartilage tissue) is useful for the "treatment of sports-related joint problems, articular cartilage defects, osteoarthritis or rheumatoid arthritis" (see page 138). This assay is not considered to impart utility to the protein PRO1565. The reason for this determination is that no results are presented, and the standard disclosed, "a positive result", is not considered to be an acceptable standard in the scientific community. It is well accepted in experimental science that, in order for a result to be positive, it must be *significantly* different from the control value, not "a positive result" as reported in the specification. In this case, it is unclear if the proteoglycan detected using the colorimetric assay, such that "a positive result" does not indicate anything more than that a trace amount of proteoglycan was present. Therefore, the assertion that the protein could be used in "treatment of sports-related joint problems, articular cartilage defects, osteoarthritis or rheumatoid arthritis" is not substantial. The Examiner further notes that he is unaware of *any* condition in which release of proteoglycan from the cartilage would be desirable,

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even if, *in arguendo*, significant amounts of the proteoglycan was released from the cartilage upon the stimulation with PRO1565 protein. On the contrary, Lafeber et al. (1999) teach that preventing the cartilage destruction and the release of proteoglycan is necessary for protecting rheumatoid arthritis patients from joint destruction (abstract). In this study it was found apocynin (a plant derived compound) diminished the release of proteoglycans from the cartilage matrix, thus preventing joint destruction. Accordingly, the tacit assertion that PRO1565 stimulates proteoglycan release from cartilage does not meet the requirements of 35 U.S.C. § 101, as the assertion of utility would not be considered substantial by a person of ordinary skill in the art.

The instant application has failed to provide guidance as to how one of skill in the art could use the claimed invention in a way that constitutes a substantial utility. The proposed uses of the claimed invention are simply starting points for further research and investigation into potential practical uses of the claimed nucleotides encoding the polypeptides. "Congress intended that no patent be granted on a chemical compound whose sole 'utility' consists of its potential role as an object of use-testing." *Brenner v. Manson*, 148 USPQ: at 696.

A substantial utility, by definition, is a utility the defines "real world" use, and a utility that requires or constitutes carrying out further research to identify or reasonably confirm a "real world" context of use is not substantial utility. In the instant case, Applicant asserts that PRO1565 stimulates the release of proteoglycans from cartilage tissue both basally and after stimulation with interleukin-1 α (if significant), at the most, is an interesting invitation for further research, experimentation and confirmation as to

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whether the PRO1565 or the polynucleotide encoding is useful as a diagnosis marker, or suitable as a therapeutic target for treatment of diseases related to cartilage and joint problems. These further research and experimentation, however, is part of the act of invention, and until it has been undertaken, the claimed invention is not considered substantial.

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8a. Claims 1-20 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above (Paragraph 7), one skilled in the art clearly would not know how to use the polynucleotide of SEQ ID NO: 115 nor polynucleotides 80, 85, 90, 95 or 99% identical to such, nor which encode a protein 80, 85, 90, 95 or 99% identical to the protein of SEQ ID NO: 116, nor polynucleotides which hybridize to any of the above.

Furthermore, even if a specific and substantial utility were subsequently established they would be enabled only for the polynucleotide of SEQ ID NO: 115 or fragments of such that are usable as hybridization probes and are not enabled for polynucleotides 80, 85, 90, 95 or 99% identical to such, nor which encode a protein 80, 85, 90, 95 or 99% identical to the protein of SEQ ID NO: 116, nor polynucleotides which

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hybridize to any of the above because there is no structural or functional information provided in the specification.

The factors considered when determining if the disclosure satisfies the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to:

1) nature of the invention, 2) state of the prior art, 3) relative skill of those in the art, 4) level of predictability in the art, 5) existence of working examples, 6) breadth of claims, 7) amount of direction or guidance by the inventor, and 8) quantity of experimentation needed to make or use the invention. In re *Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

The claims are directed to isolated polynucleotides having at least 80% identity to a SEQ ID NO: 115 or that encode the protein of SEQ ID NO: 116 with or without its signal peptide, or which encode the extracellular domain of SEQ ID NO: 116 with or without its signal peptide, or polynucleotides at least 80% identical to such encoding polynucleotides. Dependent claims are directed to polynucleotides that hybridize to the above sequences, vectors and host cells comprising the isolated polynucleotides. In the instant application, there is insufficient guidance regarding how to make PRO1565 polynucleotides variants recited in the claims.

The specification also is not enabling for the breadth of claims to polynucleotide molecules that hybridize to the disclosed sequences. It is noted that claims that recite hybridization language fail to provide adequate guidance, and do not recite that the polynucleotide encodes a protein, much less one having a specifically disclosed activity. First of all, it is pointed out that the term "hybridize" or "hybridization" generically refers to a process in which a strand of polynucleotide joins or matches up with a

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complementary strand through the process of base pairing, wherein the process is basically used to locate or identify DNAs encoding specific proteins. It is well established in the art that 15-20 bases have been considered sufficient to achieve this process. The breadth of the claims includes polynucleotides of as little as 10 nucleotides. With these points in mind, it is the Examiner's position that giving the claims their broadest reasonable interpretation, this language reads on an infinite number of possible DNA sequences for which there is not sufficient enablement without undue experimentation because of the breadth of claims, the lack of guidance provided and the quantity of experimentation needed to make or use the invention.

With respect to the hybridization use, as discussed above in paragraph 6 the invention lacks utility and thus lacks enablement. Even if utility were established, the enablement is commensurate in scope only with claims to polynucleotides that are fragments of SEQ ID NO: 115, said fragments of sufficient length to be used as hybridization probes or primers. However, enablement is *not* commensurate in scope with fragments of polynucleotides that differ from SEQ ID NO: 115 due to codon degeneracy, as it is not recognized in the art to use such sequences that are degenerate for such detection or synthesis, and the specification provides no guidance as to how or why to make such degenerate probes or primers. The specification also is not enabling for the breadth of claims to polynucleotide molecules that hybridize to the disclosed sequences because of the quantity of experimentation needed and the lack of guidance provided by the inventor.

The examples provided in the specification do not provide working examples of different DNA sequences that would enable a representative number of the above discussed DNA sequences with assurances that they can be used as probes or primers for the purpose of amplifying or detecting the PRO1565 gene. The mere recitation of this term, and the definitions provided do not serve as sufficient guidance to enable the breadth of the claims for the various DNA sequences claimed. See Ex parte Forman, 230 USPQ 546. Since the first paragraph of the statute under 35 U.S.C. 112 requires that there must be an enabling disclosure to support the breadth of the Claims, a review of the specification confirms that the scope of the various DNA sequences that are discussed above have not been enabled. There is but a single polynucleotide disclosed with reference to PRO1565, SEQ ID NO: 115. In the absence of working examples, breadth of claims and sufficient guidance, it would require undue experimentation to enable a commensurate number of the sequences that are encompassed by the claims.

Since the claimed polynucleotides are described at least in part in terms of the protein that might be encoded, the scope of the protein itself must be considered: The specification asserts that PRO1565 is an unspecified secreted and transmembrane polypeptide. However, this family of proteins does not possess a common utility, but rather the proteins that can be broadly classified and have different activities, that confer different uses on them. Accordingly, the mere identification of a protein as belonging to a family, while indicative of evolutionary relatedness, is not indicative of function, nor by extension, of utility. The structure of the putative PRO1565 peptide is briefly discussed in Figure 116, as having putative transmembrane domains, corresponding to about

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amino acids 25-47. Potential signal peptide sequence is described around amino acids 1-40. In addition, Applicants also describe potential glycosaminoglycan attachment sites around amino acids 70-73, 85-88, 92-95, 133-136, 148-151, 192-195 and 239-242. Applicant has also described potential microbodies C-terminal targeting signal site at amino acids 315-317. Further, potential N-myristoylation site around amino acids 33-38, 95-100, 116-121, 215-220 and 272-277 has been described. The specification also describes a potential cytochrome C family heme-binding site signature at around amino acids 9-14.

The problem of predicting protein structure from sequence data and in turn utilizing predicted structural determinations to ascertain functional aspects of the protein is extremely complex. While it is known that many amino acid substitutions are generally possible in any given protein, the positions within the protein's sequence where such amino acid substitutions can be made with a reasonable expectation of success are limited. Certain positions in the sequence are critical to the protein's structure/function relationship, e.g. such as various sites or regions directly involved in binding, activity and in providing the correct three-dimensional spatial orientation of binding and active sites. However, Applicant has provided little or no guidance beyond the mere presentation of sequence data to enable one of ordinary skill in the art to determine, without undue experimentation, the positions in the protein which are tolerant to change (e.g. such as by amino acid substitutions or deletions), and the nature and extent of changes that can be made in these positions. Therefore, undue

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experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope, i.e. all the polynucleotides with the various percent identities.

8b. Claims 1-5 and 15-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

To provide evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof.

The claims are drawn to polynucleotides having at least 80%, 85%, 95% or 99% sequence identity with a particular disclosed sequence, or that merely hybridize to a disclosed sequence. The claims do not require that the claimed polynucleotide encode a particular protein, nor that any protein encoded thereby possess any particular biological activity, nor any particular conserved structure, or other disclosed distinguishing feature. The specification teaches that PRO1565 has (unspecified) homology to secreted and transmembrane polypeptide. The structure of the putative PRO1565 peptide is briefly discussed in Figure 116, as having putative transmembrane domains, corresponding to about amino acids 25-47. Potential signal peptide sequence is described around amino acids 1-40. In addition, Applicants also describe potential

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glycosaminoglycan attachment sites around amino acids 70-73, 85-88, 92-95, 133-136, 148-151, 192-195 and 239-242. Applicant has also described potential microbodies C-terminal targeting signal site at amino acids 315-317. Further, potential N-myristoylation site around amino acids 33-38, 95-100, 116-121, 215-220 and 272-277 has been described. The specification also describes a potential cytochrome C family heme-binding site signature at around amino acids 9-14. However, there is no functional characteristic associated with these motifs, hence the mere observation that they exist is not probative of function or utility. Further, there is no disclosure that the protein is expected to be a transmembrane protein, nor of any extracellular domain. In this case, the only factor present in the claim is a partial structure in the form of a recitation of percent identity. There is not even identification of any particular portion of the structure that must be conserved. Accordingly, in the absence of sufficient recitation of distinguishing identifying characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, clearly states that “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.” (See page 1117.) The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” (See *Vas-Cath* at page 1116). As discussed above, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of polypeptides, and therefore conception is not achieved until

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reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1616.

One cannot describe what one has not conceived. See *Fiddes v. Baird*, 30 USPQ2d 1481 at 1483. In *Fiddes*, claims directed to mammalian FGF's were found to be unpatentable due to lack of written description for that broad class. The specification provided only the human sequence.

Therefore, polynucleotides comprising the sequence set forth in SEQ ID NO: 115 or encoding the protein of SEQ ID NO: 116, or fragments thereof sufficiently long to be used as hybridization probes but not the full breadth of the claims meet the written description provision of 35 U.S.C. 112, first paragraph. Applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. 112 is severable from its enablement provision (see page 1115).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless :

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9a. Claims 1-10 and 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lok et al., (WO 00/29579) Pub date (5/2000).

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Lok et al. describes full length cDNA sequences encoding amino acid sequence that has a 100% overall identity to SEQ ID NO: 116 (see Appendix A1). It also describes a protein sequence (SEQ ID NO: 2) that identical to SEQ ID NO: 116 (Appendix A4-A5). Thus, meeting the limitation of claims 1-7, 9, 12 and 13 of the instant invention. In addition, given this sequence identity the sequence of Lok et al., it would hybridize under stringent conditions (claims 14-16). Further, Lok et al. have described the expression of nucleotides containing vectors with promoter sequences in host cells (pages: 28-31). With respect to the limitation of "lacking its associated signal peptide" in claims 8 and 10 as Lok et al. teaches recombinant expression of the said polypeptide, the cDNA would produce the polypeptide identical to the present SEQ ID NO: 116, but lacking its associated signal peptide when transfected into the host cell. Thus, meeting the limitations of claims 8, 10, 17-20. Therefore, claims 1-20 are rejected as being anticipated by Lok et al., (WO 00/29579) Pub date (5/2000).

10. No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS 09/04


BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Notice to Comply	Application No. 10/063,730	Applicant(s) Eaton et al.	
	Examiner Scherasayn, J	Art Unit 1647	

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE
DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☐ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked-up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☐ 7. Other:

Applicant Must Provide:

- ☐ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216 or (703) 308-2923

For CRF Submission Help, call (703) 308-4212 or 308-2923

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Appendix A1

Db 667 CAGTGGTGTGCTCCCTCAAGTAAAGTAAAGAGCCCTCAGCCAGACAGCAAGTGTAG 726
 Qy 241 GUGLULEUPROFILASNAAPYTHRGUANGUYLIEGUPHASPROMETLEUASP 260
 Db 727 GAGAACTTCCAAATTAAGACTAATCTAATAATGAAATGAAATTTGATCCATGCTGAT 786
 Qy 261 GUATAGGUYTYCYCYSAILETYCYSAARGAGLYASNAAGTYCYSAARGAGVALCY 280
 Db 787 GAGAGAGGTATGT 846
 Qy 281 GUPROLEULENGUYTY 300
 Db 847 GAACTTTACTAGGCTACTACCATTCATACGCTACAGAGAGAGAGAGAGAGAGAG 906
 Qy 301 ARGVALILEMETPROCYASATPTTPVALAIAARGMETLEUGLYARGVAL 317
 Db 907 CGTGTATCATGCTGT 957

RESULT 5 BD228713 1178 bp DNA linear PAT 17-JUL-2003
 LOCUS Mammalian chondromodulin-like protein.
 DEFINITION BD228713.1 GI:33038483
 ACCESSION JP 2002530078-A/1.
 VERSION JP 2002530078-A/1.
 KEYWORDS Homo sapiens (human)
 SOURCE Homo sapiens
 ORGANISM Homo sapiens

REFERENCE 1 (bases 1 to 1178)
 AUTHORS Mammalia; Eutheria; Primates; Carnivora; Homiidae; Homo.
 TITLE Mammalian chondromodulin-like protein
 JOURNAL Patent: JP 2002530078-A 1 17-SEP-2002;
 ZYMOGENETICS INC

COMMENT OS Homo sapiens (human)
 PN JP 2002530078-A/1
 PD 17-SEP-2002
 PR 12-NOV-1999 JP 2000582562
 PR 13-NOV-1998 US 09/19186
 PI SI LOK, SCOTT R, PRESNEL
 PC C12N15/09, C07K14/51, C07K16/24, C12N15/00
 FC Mammalian chondromodulin-like protein
 FH Key Location/Qualifiers
 FT CDS Location/Qualifiers

FEATURES
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 Location/Qualifiers
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 /mol_type="Genomic DNA"
 /db_xref="taxon:9606"

ALIGNMENT Scores:
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 score: 1745.00 Matches: 317
 percent similarity: 100.00% Conservat: 0
 seq local similarity: 100.00% Mismatches: 0
 query match: 100.00% Gaps: 0

3-10-063-730-116 (1-317) x BD228713 (1-1178)

1 MetAlaValAsnProGluAspGlySerHisIleLeuAsnAlaGluAlaPhe 20
 58 AVGGCAAGAAATCTCCAGAGATGTAAGACTGTCACTTAATGCAAGAGCTTT 117
 21 LysSerLeuValCysValSerLeuValCysValSerLeuValPheGlyIleLeuAla 40
 118 AAATCCAAAGAAATATGTAATCACTTAAGATTTGTGAGCTGTGTGTGTGTGTGTGT 177
 41 LeuThrLeuIleValLeuPheTyrPylSerLysHisPheTyrProGluValProLysLys 60
 178 CTAACTCTAATGTGCTGT 237

Qy 61 AlATyTAspMeGluHisThrPheTyrSerAsnGlyGlyLysLysIleTyrMetGlu 80
 Db 238 GCCTATGACATGAGAGACATTTCTTACAGCATGAGAGAGAGAGAGAGAGAGAGAGAG 297
 Qy 81 ILASPProValThrArgThrGluIlePheArgSerGlyAsnGlyTyrAspGluThrLeu 100
 Db 298 ATGATCTGTGTGACCAAGCTGAATATTCAGAACCGAAATGGACACTGAGAAACATG 357
 Qy 101 GluValHisAspPheLysAsnGlyTyrThrGlyIleTyrPheValGlyLeuGlyLysCys 120
 Db 358 GAAGTGACACATTTAAACAGATACACTGCACTCTCTCTGTGTGTGTGTGTGTGTGTGT 417
 Qy 121 PheIleTyrThrGluIleLysValIleProGluPheSerGluProGluGluIleAsp 140
 Db 418 TTTATCAAACTCAGATTAAGTATTCCTGATTTTGTGAACCAAGAGAGAGAGAGAGAG 477
 Qy 141 GUAAGLUGLUUULETHRTHRTHRTHRTHRTHRTHRTHRTHRTHRTHRTHRTHRTHRTH 160
 Db 478 GAGAAATGAAGAAATTAACCAACTTTCTTTGAACAGTATGATTTGGGTCCAGCAGAA 537
 Qy 161 LysProIleGluAspAspPheLeuLysAsnSerLysIleLeuGluIleCysAspAsn 180
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 Db 598 GTACCATGATTTGATGATCACTCCACTTAATGATGATTTGATGATTTGATGATTTGAT 657
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 Db 658 GAGAGAGAGAGAGATCTTCACTTCTGCGCAAGAGAGAGAGAGAGAGAGAGAGAGAG 717
 Qy 221 GINTTPVALVALPROGILVALVALVALVALVALVALVALVALVALVALVALVALVAL 240
 Db 718 CAGTGGTGTGCTCCCTCAAGTAAAGTAAAGAGAGAGAGAGAGAGAGAGAGAGAGAG 777
 Qy 241 GUGLULEUPROFILASNAAPYTHRGUANGUYLIEGUPHASPROMETLEUASP 260
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 Db 838 GAGAGAGGTATGT 897
 Qy 281 GUPROLEULENGUYTY 300
 Db 898 GAACTTTACTAGGCTACTACCATTCATACGCTACAGAGAGAGAGAGAGAGAGAGAG 957
 Qy 301 ARGVALILEMETPROCYASATPTTPVALAIAARGMETLEUGLYARGVAL 317
 Db 958 CGTGTATCATGCTGT 1008

RESULT 6 AF291656 1184 bp mRNA linear PRI 07-DEC-2001
 LOCUS Homo sapiens chondromodulin-1B mRNA, complete cds.
 DEFINITION AF291656
 ACCESSION AF291656
 VERSION AF291656.1 GI:15077275
 KEYWORDS
 SOURCE
 ORGANISM Homo sapiens (human)
 Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
 Mammalia; Eutheria; Primates; Carnivora; Homiidae; Homo.
 REFERENCE 1 (bases 1 to 1184)
 TITLE A novel gene, tendin, is strongly expressed in tendons and
 ligaments and shows high homology with chondromodulin-1
 Dev. Dyn. 221 (1), 72-80 (2001)
 JOURNAL MEDLINE 2125555
 PUBMED 11357195
 REFERENCE 2 (bases 1 to 1184)
 AUTHORS Brandau, O., Aszodi, A., Meindl, A. and Fessler, R.
 TITLE Direct Submission

601 GACCATGTAATGGATCCATCCCACTCTAAATATAGTTTCTAGTACCAAGCTTTAGGA 650
|||||
609 GACCATGTAATGGATCCATCCCACTCTAAATATAGTTTCTAGTACCAAGCTTTAGGA 658

Query Match	98.4%	Score 1178;	DB 6;	Length 1178;
Best Local Similarity	100.0%	Pred. No. 2.2e-381;		
Matches 1178;	Conservative 0;	Mismatches 0;	Indels 0;	Gaps 0;

